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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,815	04/09/2004	Miles Paschini	EWIR-001/03US 300933-2009	9103
23419 7590 08/04/2010				
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EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
08/04/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,815

Applicant(s)

PASCHINI ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. The Applicants papers filed on February 5, 2010 is hereby acknowledged. Claims 1-15 and 27-33 are pending.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971). In this case, the subject matter of the instant application (host connection manager) as claimed in each independent claim is not sufficiently disclosed in the parent application (10/316,603) now U.S. Patent No. 7,522,716 in order to comply with the requirements of the first paragraph of 35 U.S.C. 112. Thus, the priority date of December 10, 2002 has not been granted.

Response to Arguments

3. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

5. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 1 fails prong (1) because the “tie” (e.g. server, host connection manager) are representative of extra-solution activity. Additionally, the claim(s) fail prong

(2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps in claim 1 are: generating a PIN at the server. The claim states “transmitting the request for the PIN from the host connection manager to a server; receiving the PIN at the host connection manager; receiving, at the host connection manager however there is no process for generating the PIN.

Claims 2-15 are either dependant upon claim 1 or contain similar limitations and are rejected for at least the same reasons.

Claim 1 further recites the feature of “a client request generated and transmitted from the client terminal, said client request indicative of the particular monetary value”, is unclear whether this is a new request or the request referrer to in the transmitting step.

An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...In re Zletz 13 USPQ2d 1320 (Fed. Cir. 1989).

Claims 2-8 are either dependant upon claim 1 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 and 27-33 are rejected under 35 U.S.C. 103(a) as being obvious in view of Brody et al. (US Patent 5,350,906) in view of Konya (US Patent 5,937,396) and further in view of Hollis (US Patent 6,628,766) and further in view of Chakris et al. (US Patent 7,630,926).

7. As per claims 1 and 9,

Brody et al. ('906) discloses a method of distributing a personal identification number (PIN) through a client terminal, comprising:
generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value;(Abstract)
transmitting the request for the PIN from the host connection manager to a server;
receiving the PIN at the host connection manager;(Column 7, lines 14-24)

Brody et al. ('906) does not explicitly disclose "sending the PIN to the client terminal in response to the client request " Konya discloses "sending the PIN to the client terminal in response to the client request " (Column 11, lines 11-26), It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) method with the Konya method in order to manage PIN codes from a centralized location.

Brody et al. ('906) does not explicitly disclose "receiving, at a host connection manager, a client request generated and transmitted from a client terminal " Hollis ('766) discloses "receiving, at a host connection manager, a client request generated and transmitted from a client terminal " (Column 3, lines 43-57; Column 5, lines 10-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) method with the Hollis ('766)'s teaching in order to manage PIN codes from a centralized location.

Brody et al. ('906) does not explicitly disclose " client request indicative of the particular monetary value " Chakris et al. ('926)discloses " client request indicative of the particular monetary value " (Column 3, lines 14-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) in view of Konya and further in view of Hollis with Chakris et al. ('926)'s teaching in order to manage PIN codes from a centralized location.

8. As per claims 2 and 10,

Brody et al. discloses the method of claim 1

wherein the generating a request for a PIN is initiated in response to the receiving of the client request at the host connection manager.(Figure 3 – when the card is read it generates a response request)

9. As per claims 3 and 11,

Brody et al. discloses the method of claim 1

wherein the generating is in advance of the receiving of the client request at the host connection manager. (Figure 1)

10. As per claims 4 and 12

Brody et al. discloses the method of claim 3, further including:

storing, at the host connection manager, the PIN in a PIN cache; and

retrieving the PIN from the PIN cache in response to the receiving of the client request at the host connection manager. (Column 7, lines 14-24)

11. As per claim 5

Brody et al. discloses the method of claim 1,

wherein the transmitting the request for the PIN includes transmitting the request for the PIN via a first network, and wherein the client request is transmitted from the client terminal to the host connection manager via a second network. (Figure 1)

12. As per claims 6 and 13

Brody et al. discloses the method of claim 5,

wherein the transmitting the request for the PIN via the first network from the host connection manager to the server is in accordance with a first communication protocol and wherein the client request is transmitted to the host connection manager from the client terminal via the second network in accordance with a second communication protocol.(Column 5, lines 22-36)

13. As per claim 7

Brody et al. discloses the method of claim 6,
wherein the first network and the second network comprise a single common network.(Figure 1)

14. As per claims 8 and 14,15

Brody et al. discloses the method of claim 1,
wherein no inventory of PINs is stored at the client terminal.(Abstract -- temporary Pin is used)

15. As per claim 27,

Brody et al. discloses the method of claim 1,
further comprising providing the PIN on a display of the client terminal. (Figure 11; column 9, lines 20-31)

16. As per claim 28,

Brody et al. discloses the method of claim 1,

further comprising printing the PIN at the client terminal. (Figure 11; column 9, lines 20-31)

17. As per claim 29

Brody et al. discloses the system of claim 9,

Brody et al. ('906) does not explicitly disclose "wherein the host connection module comprises: a server connection module configured to request, from the server, a plurality of PINs, wherein the server is coupled to a database containing PINs associated with a plurality of available products and services;

a terminal connection module configured to receive, from the client terminal, a client request for a PIN wherein the request indicates user selection of a selected one of the products and services; and

a controller coupled to the terminal connection module and the server connection module, wherein the controller is configured to initiate transmission of the requested PIN to the client terminal in response to the client request.

" Hollis ('766) discloses "wherein the host connection module comprises: a server connection module configured to request, from the server, a plurality of PINs, wherein the server is coupled to a database containing PINs associated with a plurality of available products and services;

a terminal connection module configured to receive, from the client terminal, a client request for a PIN wherein the request indicates user selection of a selected one of the products and

services; and

a controller coupled to the terminal connection module and the server connection module, wherein the controller is configured to initiate transmission of the requested PIN to the client terminal in response to the client request". (Column 3, lines 43-57; Column 5, lines 10-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) method with the Hollis ('766)'s teaching in order to manage PIN codes from a centralized location.

18. As per claims 30-32,

Brody et al. discloses the system of claim 30,

Brody et al. ('906) does not explicitly disclose "wherein the controller is configured to initiate a connection with the server, in advance of the client terminal requesting the PIN, in order to receive a quantity of PINS associated with the plurality of available products and services and store the quantity of PINS in the PIN cache". Hollis ('766) discloses "wherein the controller is configured to initiate a connection with the server, in advance of the client terminal requesting the PIN, in order to receive a quantity of PINS associated with the plurality of available products and services and store the quantity of PINS in the PIN cache ". (Column 7, lines 26-44 – Examiner notes that A wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)). It would have been obvious to

one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) method with the Hollis ('766)'s teaching in order to manage PIN codes via a network.

19. As per claim 33,

Brody et al. discloses the system of claim 29,

Brody et al. ('906) does not explicitly disclose "wherein the server connection module is configured to communicate with the server in accordance with a first communication protocol and the terminal connection module is configured to communicate with the client terminal in accordance with a second communication protocol". Hollis ('766) discloses "wherein the server connection module is configured to communicate with the server in accordance with a first communication protocol and the terminal connection module is configured to communicate with the client terminal in accordance with a second communication protocol". (Column 6, lines 34-50 – Examiner notes that "second communication protocol is merely a duplication of a claim element and does not have patentable merit , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Brody et al. ('906) method with the Hollis ('766)'s teaching in order to manage PIN codes via a network.

20. In regard to claims 9-15 and 29-33 Examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be

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distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

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/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685